

REMARKS

This Reply is respectfully submitted in response to the Office Action mailed on January 29, 2009.

In the Office Action, the Examiner withdrew claims 16-27 as being directed to a different invention from claims 1-15; rejected claims 1, 4-6, 12, and 15 under 35 U.S.C. § 102(b) as allegedly being anticipated by Polaschegg et al. (U.S. Patent No. 6,156,002); rejected claims 2 and 3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polaschegg et al. in view of Ericson et al. (U.S. Patent No. 6,139,748); rejected claims 7-11 as allegedly being unpatentable over Polaschegg et al. in view of Schmidtke et al. (U.S. Patent No. 5,457,535); and rejected claims 13 and 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polaschegg et al. in view of Tobe et al. (WO/95/08299).

By this Reply, Applicant has cancelled claim 2, and amended claims 1 and 3 to clarify the claimed invention. No new matter has been added by these amendments. After entry of this Reply, claims 1 and 3-27 will remain pending. Of these, claims 16-27 are withdrawn and claims 1 and 16 are the sole independent claims.

§ 102(b) Rejection of Claims 1, 4-6, 12, and 15

Applicant respectfully traverses the rejection of claims 1, 4-6, 12, and 15 under 35 U.S.C. § 102(b) as allegedly being anticipated by Polaschegg et al. Applicant respectfully disagrees with the Examiner's arguments and conclusions, and submits that currently amended independent claim 1 is patentably distinguishable over Polaschegg et al. at least for the reasons set forth below.

In order to properly establish that Polaschegg et al. anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of independent claim 1 must be disclosed, either expressly or under principles of inherency, in that single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Currently amended claim 1 has been amended to recite features recited in previously-presented dependent claim 2 (now canceled). In particular, amended independent claim 1 now recites an apparatus comprising, among other things, "a plurality of inlets configured to introduce different matters to be mixed with each other; at least one conduit configured to convey a fluid to one of the inlets; and a measurement unit for measuring at least one substance of said fluid in the conduit before the fluid is mixed with the different matters introduced through said inlets" (emphasis added).

The Examiner contends that Polaschegg et al. discloses, "a conduit in which a dialysis infusion fluid is intended to flow (10), comprising a measurement unit (172)." (Office Action, page 3). With regard to claim 2,¹ the Examiner concedes that "POLASCHEGG does not appear to expressly disclose that the measurement unit measures said substance before fluid is mixed with other matters." (Office Action, page 4.) Accordingly, Polaschegg et al. does not disclose each and every element of

¹ Claim 1 has been amended to include certain features of claim 2, which the Examiner rejected under 35 U.S.C. § 103(a) in view of Ericson et al.

amended independent claim 1. Thus, independent claim 1 is allowable over Polaschegg et al. and Applicant respectfully requests that the Examiner withdraw the § 102(b) rejection of amended independent claim 1. Moreover, claims 4-6, 12, and 15 are allowable over Polaschegg et al. due at least to their dependence from allowable independent claim 1. Applicant respectfully requests that the § 102(b) rejection of these claims be withdrawn as well.

§103 Rejection of Claims 2 and 3

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Polaschegg et al. in view of Ericson. Claim 2 has been canceled by this Reply and claim 3 has been amended to depend from amended independent claim 1. Moreover, as discussed above, independent claim 1 has been amended to recited features recited in previously presented (now canceled) claim 2. Accordingly, to the extent this § 103(a) applies to amended independent claim 1, Applicant responds in the following paragraphs.

As discussed above, with regard to claim 2, the Examiner concedes that "POLASCHEGG does not appear to expressly disclose that the measurement unit measures said substance before fluid is mixed with other matters." (Office Action, page 4.) To cure this deficiency of Polaschegg et al., the Examiner contends that "ERICSON discloses a plurality of inlets for different matters (Fig. 1, Refs. 3-5),...it is implicit that the concentration of the substance is measured prior to being mixed with other different matters introduced via different inlets, and it would be obvious to a person having ordinary skill in the art to use the measurement unit of POLASCHEGG as it measure concentrations of glucose (C7/L1-5)." (Office Actions, pages 4-5.) Applicant disagrees

with the Examiner's interpretations of Polaschegg et al. and Ericson et al. and conclusions of law.

Polaschegg et al. discloses a "first optional sensor for the clearance measurement 172" and a "second sensor for clearance measurement 174". Together, "the sensor 174 and optional sensor 172 are connected to an evaluation unit 190" for the purpose of determining the "amount of substance not dialyzed in the dialyzer" (emphasis added). (Abstract, Col. 3, lines 32-35.) In other words, Polaschegg et al. is concerned with measuring mass and energy transfer parameters (clearance and dialysance). In order to achieve this objective, the first optional sensor follows downstream in the conduit from the injection site 170 (Col. 3, lines 23-25) and the "second sensor for clearance measurement is preferably situated downstream of the bypass valve in the waste line." (Col. 3, lines 35-36.)

Ericson et al. discloses a dialysis machine having a water inlet 1, a preparatory unit 2, and a plurality of input concentrates 3, 4, and 5. (Col. 5, lines 14-19.) Applicant disagrees with the Examiner's contention that Ericson et al. "implicitly" discloses that the "concentration of the substance is measured prior to being mixed with other different matters introduced via different inlets." Applicant also disagrees with the Examiner's contention that "it would have been obvious to a person having ordinary skill in the art to use the measurement unit of POLASCHEGG" [with the apparatus of Ericson et al.].

Nevertheless, even if the measurement unit of Polaschegg et al. were combined with the apparatus of Ericson et al., the combination would not teach or suggest the apparatus of claim 1. Specifically, because the first optional sensor 172 of Polaschegg et al. is positioned downstream from the injection site 170, it would also be positioned

downstream from the preparation unit 2 of Ericson et al., if at all. Likewise, the second sensor for clearance measurement 174 would be positioned downstream from the dialyzer (200 in Polaschegg et al.; 17 in Ericson et al.). Therefore, neither Polaschegg et al. nor Ericson et al. teaches or suggests, “a plurality of inlets configured to introduce different matters to be mixed with each other; at least one conduit configured to convey a fluid to one of the inlets; and a measurement unit for measuring at least one substance of said fluid in the conduit before the fluid is mixed with the different matters introduced through said inlets,” as recited in currently-amended independent claim 1 (emphasis added).

In fact, the combination of Polaschegg et al. and Ericson et al. teaches away from the recitations of independent claim 1, at least due to the positions of sensors 172 and 174 relative to injection site 170 and dialyzer 200 in Polaschegg et al. Even if sensor 172 were positioned in the apparatus of Ericson et al. it would only measure fluids after they have been combined from inputs 3 and 4, and therefore not, “before the fluid is mixed,” as recited in currently-amended independent claim 1. Even if the inputs 3 and 4 of Ericson et al. were added to the apparatus of Polaschegg et al. these inputs would be positioned at injection site 170, with a downstream first optional sensor 172, and therefore not disclose “a measurement unit for measuring at least one substance of said fluid in the conduit before the fluid is mixed,” as recited in currently-amended independent claim 1.

Accordingly, amended independent claim 1 is allowable over Polaschegg et al. in view of Ericson et al. for the reasons discussed above. Thus, dependent claim 3 is allowable over Polaschegg et al. and Ericson et al. due at least to its dependence, from

amended independent claim 1, and due to its additional recitations of novel subject matter.

§103 Rejection of Claims 7-11

Claims 7-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Polaschegg et al. in view of Schmidtke et al. Applicant traverses this rejection. Claims 7-11 depend from amended independent claim 1 and are allowable over the cited references. As discussed above, Polaschegg et al. does not teach or suggest, “a plurality of inlets configured to introduce different matters to be mixed with each other; at least one conduit configured to convey a fluid to one of the inlets; and a measurement unit for measuring at least one substance of said fluid in the conduit before the fluid is mixed with the different matters introduced through said inlets,” as recited in currently-amended independent claim 1 (emphasis added). Schmidtke et al. discloses means arranged to generate a warning signal. Schmidtke et al. fails, however, to cure the above-mentioned deficiencies of Polaschegg et al., and thus, claims 7-11 are allowable at least due to their dependence from allowable independent claim 1 and for their additional recitations of novel subject matter.

§103 Rejection of Claims 13 and 14

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Polaschegg et al. in view of Tobe et al. Applicant traverses this rejection. Claims 13 and 14 depend from amended independent claim 1 and are allowable over the cited references. As discussed above, Polaschegg et al. does not teach or suggest, “a plurality of inlets configured to introduce different matters to be mixed with each other; at least one conduit configured to convey a fluid to one of the inlets; and a

measurement unit for measuring at least one substance of said fluid in the conduit before the fluid is mixed with the different matters introduced through said inlets," as recited in currently-amended independent claim 1 (emphasis added). Tobe et al. discloses a container with first and second compartments. Tobe et al. fails, however, to cure the above-mentioned deficiencies of Polaschegg et al., and thus, claims 13 and 14 are allowable at least due to their dependence from allowable independent claim 1 and for their additional recitations of novel subject matter.

Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against the pending claims. Applicant therefore requests the entry of this Reply and the amendments contained herein, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Should it be necessary to resolve any additional concerns and expedite the issuance of a Notice of Allowance, the Examiner is invited to contact Applicant's undersigned representative at (202) 408-4387.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 29, 2009

By: /Aaron L. Parker/
Aaron L. Parker
Reg. No. 50,785